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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/663,183 09/15/00 DEPUIS

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EXAMINER

HM12/1023

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WASHINGTON DC 20005-3315

WELLS, L

ART UNIT	PAPER NUMBER
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1619

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/663,183

Applicant(s)

DEPUIS, CHRISTINE

Examiner

Lauren Q Wells

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-102 are pending.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed September 18, 2001 (Paper No. 9) to the rejection of claims 1-102 made by the Examiner under 35 USC 103, 112 and the judicially created doctrine of obviousness type double patenting have been fully considered and deemed not persuasive. The Applicant's arguments to the rejection of claims 1-102 made by the Examiner under 35 USC 101 (statutory type double patenting) have been fully considered and deemed persuasive. The said rejection is hereby withdrawn.

Double Patenting Rejection Maintained

The rejection of claims 1-102 under the judicially created doctrine of obviousness type double patenting is MAINTAINED for the reasons set forth in the Office Action mailed April 11, 2001, Paper No. 7, and those found below.

For clarity, claims 1-102 of the instant invention are provisionally rejected over claims 1-76 of copending Application No. 09662796.

Per the Applicant's request, this rejection will be held in abeyance until allowable subject matter is indicated.

112 Rejection Maintained

The rejection of claims 1-102 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed April 11, 2001, Paper No. 7, and those found below.

(i) The terms "derivatives" and "carbon based unsaturated compounds" are still vague and indefinite. For example, in claim 8, what compounds are encompassed by the phrases "derivatives of linear C1-C40 alkyls, derivatives of branched C3-C40 alkyls. . . derivatives of polyalkylene glycols"? The vast number of compounds encompassed by these phrases is innumerable. Thus, the specification does not define all these compounds and one of ordinary skill in the art would not be appraised of them.

103 Rejection Maintained

The rejection of claims 1-102 under 35 U.S.C. 103(a) as being unpatentable over is MAINTAINED for the reasons set forth in the Office Action mailed April 11, 2001, Paper No. 7, and those found below.

Applicant argues that "Blackenburg is not even concerned with a composition that comprises at least one nonionic polymer that includes at least one vinyl lactam unit". This argument is not persuasive. First, the rejection of the claims of the instant invention is over the combination of Blackenburg in view of Myers et al. and not solely over Blackenburg. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Second, Blackenburg teaches that other polymers, such as copolymers of ethylenically unsaturated monomers, which a nonionic polymer that includes at least one vinyl lactam unit is, may be present during polymerization of monomers, and that such polymers may be added to the polymer preparations after polymerization.

Art Unit: 1619

Applicant argues that "The Examiner has not shown that the references suggest or disclose the claimed invention, and neither has the Examiner proven any motivation to combine the references with a reasonable expectation of success" and that "Myers does not teach or suggest the usage of polyvinyl lactam polymers with all types of hair spray formulations". These arguments are not persuasive. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Blackenburg using the teachings of Myers and obtain a composition comprising a silicone/acrylate copolymer and a nonionic polymer comprising at least one vinyl lactam unit because a) Blackenburg and Myers both teach hair care compositions in the form of sprays; b) Myers specifically teaches vinyl lactams for use in hair spray formulations; c) Blackenburg teaches that vinyl lactam homo and copolymers are known in the art as synthetic polymers that have been used for almost 50 years to strengthen hairdos, which is the purpose of hairspray; d) Blackenburg teaches that other polymers, such as copolymers of ethylenically unsaturated monomers, which a nonionic polymer that includes at least one vinyl lactam unit is, may be present during polymerization of monomers, and that such polymers may be added to the polymer preparations after polymerization; e) Blackenburg teaches vinyl lactams as the acrylate portion of his silicone/acrylate copolymer.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 1619


MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
October 4, 2001



DAMERON L. JONES
PRIMARY EXAMINER